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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/007,496

10/22/2001

Timothy I. Moodycliffe

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EXAMINER

WEBB, GREGORY E

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,496

Applicant(s)

MOODYCLIFFE, TIMOTHY I.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 15-20 are objected to because of the following informalities: These claims ultimately depend from cancelled claim 14. Appropriate correction is required.

Claim 21 is objected to because of the following informalities: The applicant has incorrectly spelled "shear" as "sheer." Appropriate correction is required.

Response to Amendment

The following is in response to the applicant's amendments and comments filed 5/6/2005. Based on the applicant's arguments and amendments, the examiner has withdrawn all previous rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The applicant's claims are directed to a composition with the following material limitations: there must be no water contained in the composition (non-aqueous) and the composition is liquid;

- a) the composition must contain a petroleum distillate;
- b) the composition must contain a triblock copolymer and a hydrocarbon oil (noting that a hydrocarbon oil also meets the limitation of petroleum distillate);
- c) the ratio of the triblock copolymer to the hydrocarbon oil is defined.

Concerning the fluid properties of the composition, the examiner will do the best at meeting these functional limitations. However, should all the above material limitations be met by the prior art, the examiner will consider such functional limitations as inherent to the prior art compositions.

Concerning claim 18, this claim merely defines the intended use of the composition and does not materially limit the claims by defining required compounds or functional properties.

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It should be further noted that the applicant's "thickener" is a sub-composition. Should the examiner find a composition containing all the material limitation, it would not be required to find the thickener mixed separately and added to the bulk composition. The examiner is only required to find each and every component. Limitations such as separate addition would be best defined by a method or process claim as the instant compositions are limited by materials and not by order of addition.

Claims 13, 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrison et al (US 6,433,068).

Morrison teaches hydrocarbon gels which are useful for suspending or dispersing solids (see abstract). Morrison teaches in claim 1 a composition containing 20-95% hydrocarbon (i.e. also a petroleum distillate), 0.1-50% of a triblock copolymer, and solids (see claim 1).

Morrison teaches various suitable hydrocarbons including mineral oils, mineral solvents, mineral spirits, animal/vegetable oils, and mixtures thereof (see col. 4, lines 41-49).

Claims 13, 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Graveske (US 6,350,810).

Graveske teaches a waterproofing composition containing hydrocarbons and polymers (see abstract). Graveske teaches the inclusion of solvents such as hydrocarbons, toluene, xylene, benzene and mineral spirits (see col. 7, lines 29-46) in amounts ranging from 0.2-4 times the

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amount of polymeric binder resin added or approximately 9-71% of the composition (see claim 1 and col. 8, lines 15-22).

Graveske further teaches the use of triblock copolymers in amounts ranging from 0.5-0.9 times the amount of polymeric binder (see claim 1 and col. 6, lines 21-37).

Graveske further teaches spraying the composition on substrates (see col. 11, lines 38-48).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 13, 15-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,433,068. Although the conflicting claims are not identical, they are not patentably distinct from each other because each and every material limitation is taught by claim 1 of '068.

For example claim 1 of '068 teaches 20-95% hydrocarbon (i.e. petroleum distillate), 0.1-50% of the triblock copolymer, and the composition is non-aqueous.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb
Primary Examiner
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gew